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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,160	09/26/2001	John A. M. Cameron	WEAT/0150	9581

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EXAMINER

ROMAR, THOMAS S

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/964,160

Applicant(s)

CAMERON, JOHN A. M.

Examiner

Shane Bomar

Art Unit

3672

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 December 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: 18-23,26,32,33,43 and 44.

Claim(s) objected to: _____.

Claim(s) rejected: 1-3,9,13-17,24,25,27-29,34-42,45 and 46.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 12/23/04.
10. ☐ Other: _____


DAVID BAGNELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Continuation of 5. does NOT place the application in condition for allowance because: the rejections set forth by the examiner in the Final Rejection mailed on 10/14/2004 are still deemed valid. The applicant first argues that there is no motivation to combine Evans and Castano-Mears because Evans does not teach using expandable tubing in place of production tubing. Although it is true that Evans does not teach using expandable tubing in place of production tubing, it is also true that expandable production tubing was not well known in the art when the Evans patent was issued. At the time the Castano-Mears patent was issued, it was notoriously known in the art to use expandable tubing for production of hydrocarbons. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to dispose the encapsulation of Evans between the expandable tubing of Castano-Mears and a wall of a wellbore. One would have been motivated to make such a combination because Evans teaches that control lines in an encapsulation are protected and easily handled in the wellbore environment, and because Castano-Mears have shown it to be notoriously known in the art that control lines can be disposed between an expandable downhole tool and the wall of the wellbore. Furthermore, it is currently claimed that "the encapsulation is disposable between an expandable downhole tool and a wall of a wellbore", which the Office interprets to mean that the encapsulation only needs to be capable of performing this function. The encapsulation of Evans is clearly capable of being disposed between an expandable tool and a wall of a wellbore. The applicant further argues that the combination of references would require a substantial reconstruction and redesign of the elements since the packer E taught by Evans prevents movement of the encapsulation into the annulus and because of the presence of the strap or clamp 10. First, the packer E does prevent the encapsulation from moving into the annulus but only above the surface S where, as is well known in the art, the tubing would not be expanded. Second, it is also notoriously known in the expansion art that selected portions of a tubular can be expanded downhole, therefore the clamp would be placed in a position that will not be expanded.